

Case 6:09-cv-00448-JDL Document 231 Filed 05/18/10 Page 1 of 15 PageID #: 2736

U.S. ETHERNET INNOVATIONS, LLC.,

Plaintiff,

V.

ACER, INC.,  
ACER AMERICA CORP.,  
APPLE, INC.,  
ASUS COMPUTER INTERNATIONAL,  
ASUSTEK COMPUTER INC.,  
DELL INC.,  
FUJITSU LTD.,  
FUJITSU AMERICA, INC.,  
GATEWAY, INC.,  
HEWLETT PACKARD CO.,  
SONY CORP.,  
SONY CORP. OF AMERICA,  
SONY ELECTRONICS INC.,  
TOSHIBA CORP.,  
TOSHIBA AMERICA, INC., and  
TOSHIBA AMERICA  
INFORMATION SYSTEMS, INC.,

Defendants.

§ §

CIVIL ACTION NO. 6:09-cv-448 JDL

JURY TRIAL DEMANDED

**ANSWER AND COUNTERCLAIMS OF  
ASUS COMPUTER INTERNATIONAL AND ASUSTEK COMPUTER INC.  
(COLLECTIVELY “ASUS”)  
TO FIRST AMENDED COMPLAINT FOR PATENT INFRINGEMENT OF  
U.S. ETHERNET INNOVATIONS, LLC (“USEI”)**

ASUS answers the allegations made in USEI's First Amended Complaint for Patent Infringement (the "Complaint") as follows:

### **NATURE OF THE ACTION**

1. ASUS lacks sufficient information to admit or deny the allegation that USEI owns United States Patent Nos. 5,307,459 (the “’459 patent”), 5,434,872 (the “’872 patent”), 5,732,094 (the “’094 patent”) and/or 5,299,313 (the “’313 patent”) (collectively, patents-in-suit), and for that reason denies the same.

2. ASUS denies the allegations in Paragraph 2 to the extent that they are directed at ASUS. ASUS otherwise lacks sufficient information to admit or deny the allegations in Paragraph 2, and for that reason denies the same.

3. ASUS admits that USEI seeks damages for each Defendant’s alleged infringement of the patents-in-suit, but ASUS denies liability for infringement of the patents-in-suit and that USEI is entitled to damages from ASUS.

### **PARTIES**

4. ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 4, and for that reason denies the same.

5. ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 5, and for that reason denies the same.

6. ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 6, and for that reason denies the same.

7. ASUS admits that ASUSTeK Computer Inc. (“ASUSTeK”) is a Taiwanese company with a principal place of business at No. 15, Li-Te Road, Peitou District, Taipei 112, Taiwan R.O.C., and that ASUS Computer International (“ACI”) is a wholly owned subsidiary of ASUSTeK and a California company with a principal place of business at 800 Corporate Way, Fremont, California 94539.

8. ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 8, and for that reason denies the same.

9. ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 9, and for that reason denies the same.

10. ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 10, and for that reason denies the same.

11. ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 11, and for that reason denies the same.

12. ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 12, and for that reason denies the same.

#### **JURISDICTION AND VENUE**

13. ASUS admits that all of the claims asserted in the Complaint arise under 35 U.S.C. § 101, *et seq.*

14. ASUS admits that this Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338(a).

15. To the extent the allegations in paragraph 15 relate to ASUS, ASUS admits that venue is authorized in this Court, but ASUS denies that this District is the most convenient forum for this case. ASUS denies all other allegations in paragraph 15 to the extent such allegations relate to ASUS. To the extent the allegations in paragraph 15 relate to the other Defendants in this case, ASUS lacks sufficient information to admit or deny the allegations, and for that reason denies the same.

16. For purposes of this case, ASUS admits that it is subject to personal jurisdiction in Texas. ASUS otherwise lacks sufficient information to admit or deny the allegations set forth in

Paragraph 16, and for that reason denies the same.

**PATENTS-IN-SUIT**

**17.** On information and belief, ASUS admits that a copy of the '459 patent is attached to USEI's Complaint as Exhibit A. ASUS also admits that, according to the cover page of the '459 patent attached to USEI's Complaint as Exhibit A, it is entitled "Network Adapter with Host Indication Optimization" and issued on April 26, 1994. ASUS further admits that, according to the cover page of the '459 patent attached to USEI's Complaint as Exhibit A, 3Com Corporation is listed as the assignee, and Brian Peterson, W. Paul Sherer, David R. Brown and Lai-Chin Lo listed as the inventors. ASUS denies all remaining allegations in Paragraph 17 of USEI's Complaint.

**18.** On information and belief, ASUS admits that a copy of the '872 patent is attached to USEI's Complaint as Exhibit B. ASUS also admits that, according to the cover page of the '872 patent attached to USEI's Complaint as Exhibit B, it is entitled "Apparatus for Automatic Initiation of Data Transmission" and issued on July 18, 1995. ASUS further admits that, according to the cover page of the '872 patent attached to USEI's Complaint as Exhibit B, 3Com Corporation is listed as the assignee, and Brian Peterson, David R. Brown and W. Paul Sherer listed as inventors. ASUS denies all remaining allegations in Paragraph 18 of USEI's Complaint.

**19.** On information and belief, ASUS admits that a copy of the '094 patent is attached to USEI's Complaint as Exhibit C. ASUS also admits that, according to the cover page of the '094 patent attached to USEI's Complaint as Exhibit C, it is entitled "Method for Automatic Initiation of Data Transmission" and issued on March 24, 1998. ASUS further admits that, according to the cover page of the '094 patent attached to USEI's Complaint as Exhibit C, 3Com

Corporation is listed as the assignee, and Brian Peterson, David R. Brown and W. Paul Sherer listed as inventors. ASUS denies all remaining allegations in Paragraph 19 of USEI's Complaint.

**20.** On information and belief, ASUS admits that a copy of the '313 patent is attached to USEI's Complaint as Exhibit D. ASUS also admits that, according to the cover page of the '313 patent attached to USEI's Complaint as Exhibit D, it is entitled "Network Interface with Host Independent Buffer Management" and issued on March 29, 1994. ASUS further admits that, according to the cover page of the '313 patent attached to USEI's Complaint as Exhibit D, 3Com Corporation is listed as the assignee, and Brian Peterson, W. Paul Sherer, David R. Brown and Lai-Chin Lo listed as inventors. ASUS denies all remaining allegations in Paragraph 20 of USEI's Complaint.

**21.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 21, and for that reason denies the same.

### **ACCUSED PRODUCTS**

**22.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 22, and for that reason denies the same.

**23.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 23, and for that reason denies the same.

**24.** ASUSTeK admits that it makes, uses, offers for sale and/or sells P4T533-C Motherboard, P4PE Motherboard, AP1710-E1 Server and/or Rampage II Extreme, and ACI admits that it imports, uses, offers for sale and/or sells P4T533-C Motherboard, P4PE Motherboard, AP1710-E1 Server and/or Rampage II Extreme. ASUS denies that P4T533-C Motherboard, P4PE Motherboard, AP1710-E1 Server, Rampage II Extreme and/or any other

ASUS products embody any claims of the patents-in-suit. ASUS further denies all remaining allegations in Paragraph 24 of USEI's Complaint.

**25.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 25, and for that reason denies the same.

**26.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 26, and for that reason denies the same.

**27.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 27, and for that reason denies the same.

**28.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 28, and for that reason denies the same.

**29.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 29, and for that reason denies the same.

## **COUNT I**

### **INFRINGEMENT OF U.S. PATENT NO. 5,307,459**

**30.** ASUS restates and incorporates by reference its responses to the allegations in paragraphs 1-29 of USEI's Complaint.

**31.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 31, and for that reason denies the same.

**32.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 32, and for that reason denies the same.

**33.** ASUS denies all allegations in Paragraph 33 of USEI's Complaint.

**34.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 34, and for that reason denies the same.

**35.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 35, and for that reason denies the same.

**36.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 36, and for that reason denies the same.

**37.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 37, and for that reason denies the same.

**38.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 38, and for that reason denies the same.

## **COUNT II**

### **INFRINGEMENT OF U.S. PATENT NO. 5,434,872**

**39.** ASUS restates and incorporates by reference its responses to the allegations in paragraphs 1-29 of USEI's Complaint.

**40.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 40, and for that reason denies the same.

**41.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 41, and for that reason denies the same.

**42.** ASUS denies all allegations in Paragraph 42 of USEI's Complaint.

**43.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 43, and for that reason denies the same.

**44.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 44, and for that reason denies the same.

**45.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 45, and for that reason denies the same.

**46.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 46, and for that reason denies the same.

**47.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 47, and for that reason denies the same.

### **COUNT III**

#### **INFRINGEMENT OF U.S. PATENT NO. 5,732,094**

**48.** ASUS restates and incorporates by reference its responses to the allegations in paragraphs 1-29 of the Complaint.

**49.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 49, and for that reason denies the same.

**50.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 50, and for that reason denies the same.

**51.** ASUS denies all allegations in Paragraph 51 of USEI's Complaint.

**52.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 52, and for that reason denies the same.

**53.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 53, and for that reason denies the same.

**54.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 54, and for that reason denies the same.

**55.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 55, and for that reason denies the same.

**56.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 56, and for that reason denies the same.



**COUNT IV**

**INFRINGEMENT OF U.S. PATENT NO. 5,299,313**

**57.** ASUS restates and incorporates by reference its responses to the allegations in paragraphs 1-29 of the Complaint.

**58.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 58, and for that reason denies the same.

**59.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 59, and for that reason denies the same.

**60.** ASUS denies all allegations in Paragraph 60 of USEI's Complaint.

**61.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 61, and for that reason denies the same.

**62.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 62, and for that reason denies the same.

**63.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 63, and for that reason denies the same.

**64.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 64, and for that reason denies the same.

**65.** ASUS lacks sufficient information to admit or deny the allegations set forth in Paragraph 65, and for that reason denies the same.

**PRAYER FOR RELIEF**

ASUS opposes any relief sought by USEI in its Prayer for Relief or any other relief against ASUS.

**AFFIRMATIVE DEFENSES**

ASUS incorporates by reference the foregoing paragraphs in their entirety and asserts the following Affirmative Defenses. ASUS reserves the right to amend its answer with additional defenses as further information becomes available.

**FIRST AFFIRMATIVE DEFENSE**  
**(No Infringement)**

1. ASUS does not infringe and has not infringed any valid and enforceable claim of the '459, '872, '094 or '313 patent.
2. ASUS does not induce or contribute to and has not induced or contributed to infringement of any valid and enforceable claim of the '459, '872, '094 or '313 patent.

**SECOND AFFIRMATIVE DEFENSE**  
**(Invalidity)**

3. Each asserted claim of the '459, '872, '094 and '313 patents is invalid for failing to satisfy the conditions for patentability set forth in Title 35 of the United States Code, including without limitation 35 U.S.C. §§ 101, 102, 103 and 112.

**THIRD AFFIRMATIVE DEFENSE**  
**(Laches)**

4. USEI's claims for relief are barred in whole or in part by laches.

**FOURTH AFFIRMATIVE OR OTHER DEFENSE**  
**(Estoppel)**

5. USEI's claims are barred in whole or in part by estoppel.

**FIFTH AFFIRMATIVE DEFENSE**  
**(License)**

6. Some or all of ASUS's products have been licensed.

**SIXTH AFFIRMATIVE DEFENSE**  
**(Exhaustion)**

7. USEI's claims are barred in whole or in part by patent exhaustion.

**SEVENTH AFFIRMATIVE DEFENSE**  
**(No Fees, Costs or Damages)**

8. USEI has failed to plead and/or meet the requirements under 35 U.S.C. §§ 284-288, and has otherwise failed to show that it is entitled to any fees, costs or damages.

**JURY DEMAND**

ASUS also demands a jury trial on all issues so triable.

**COUNTERCLAIMS OF ASUSTEK COMPUTER INC. AND ASUS COMPUTER  
INTERNATIONAL (COLLECTIVELY "ASUS") AGAINST U.S. ETHERNET  
INNOVATIONS, LLC ("USEI")**

ASUS complains of counter-defendant USEI and alleges as follows:

**THE PARTIES**

1. ASUSTeK Computer Inc. ("ASUSTeK") is a Taiwanese company with a principal place of business at No. 15, Li-Te Road, Peitou District, Taipei 112, Taiwan R.O.C. ASUS Computer International ("ACI") is a wholly owned subsidiary of ASUSTeK and a California company with a principal place of business at 800 Corporate Way, Fremont, California 94539.

2. On information and belief based upon USEI's Complaint, USEI is a Texas limited liability company having a principal place of business in Tyler, Texas.

**JURISDICTION AND VENUE**

3. These counterclaims arise under the Declaratory Judgment Act, 28 U.S.C. §2201 et seq., and the patent laws, 35 U.S.C. § 101 et seq. This Court has subject matter jurisdiction

over the counterclaims under 28 U.S.C. §§ 1331 and 1338(a). This Court has further subject matter jurisdiction under 28 U.S.C. §§ 1332 and 1367(a).

4. This court has personal jurisdiction over USEI because, on information and belief, USEI's principal place of business is in this District, and because USEI has filed suit against ASUS in this District and hence has purposefully availed itself in this District.

5. Venue on these counterclaims is proper in this District under 28 U.S.C. § 1391(b) because USEI alleges that its principal place of business is located in this District.

### **FIRST COUNTERCLAIM**

#### **DECLARATION OF NO INFRINGEMENT**

6. An actual controversy has arisen and now exists between ASUS and USEI as to the infringement of U.S. Patent Nos. 5,307,459 (the "'459 patent"), 5,434,872 (the "'872 patent"), 5,732,094 (the "'094 patent") and 5,299,313 (the "'313 patent") because of the patent action filed by USEI against ASUS.

7. Pursuant to the Federal Declaratory Judgment Act, 28 U.S.C. § 2201 et seq., ASUS seeks the declaration of the Court that ASUS does not infringe and has not infringed any valid and enforceable claim of the '459, '872, '094 or '313 patent.

8. Pursuant to the Federal Declaratory Judgment Act, 28 U.S.C. § 2201 et seq., ASUS seeks the declaration of the Court that ASUS does not induce or contribute to and has not induced or contributed to infringement of any valid and enforceable claim of the '459, '872, '094 or '313 patent.

### **SECOND COUNTERCLAIM**

#### **DECLARATION OF INVALIDITY**

9. An actual controversy has arisen and now exists between ASUS and USEI as to

the validity of the '459, '872, '094 and '313 patent because of the patent action filed by USEI against ASUS.

10. ASUS seeks the declaration of the Court that each asserted claim of the '459, '872, '094 and '313 patents is invalid for failing to satisfy the conditions for patentability set forth in Title 35 of the United States Code, including without limitation 35 U.S.C. §§ 101, 102, 103 and 112.

**PRAYER FOR RELIEF**

ASUS respectfully requests that this Court enter a judgment against USEI as follows:

- A. ASUS does not infringe, has not infringed, does not induce or contribute to the infringement of, and has not induced or contributed to the infringement of any valid and enforceable claim of U.S. Patent No. 5,307,459;
- B. ASUS does not infringe, has not infringed, does not induce or contribute to the infringement of, and has not induced or contributed to the infringement of any valid and enforceable claim of U.S. Patent No. 5,434,872;
- C. ASUS does not infringe, has not infringed, does not induce or contribute to the infringement of, and has not induced or contributed to the infringement of any valid and enforceable claim of U.S. Patent No. 5,732,094;
- D. ASUS does not infringe, has not infringed, does not induce or contribute to the infringement of, and has not induced or contributed to the infringement of any valid and enforceable claim of U.S. Patent No. 5,299,313;
- E. Each asserted claim of U.S. Patent No. 5,307,459 is invalid;
- F. Each asserted claim of U.S. Patent No. 5,434,872 is invalid;
- G. Each asserted claim of U.S. Patent No. 5,732,094 is invalid;
- H. Each asserted claim of U.S. Patent No. 5,299,313 is invalid;
- I. USEI's claims against ASUS are dismissed in their entirety with prejudice;

- J. This case is exceptional under 35 U.S.C. § 285, and ASUS is entitled to recover its costs and reasonable attorneys' fees; and
- K. ASUS is entitled to whatever further relief the Court may deem just and proper.

**JURY DEMAND**

ASUS hereby demands a jury trial on all issues so triable.

Dated: May 18, 2010

Respectfully submitted,

/s/ Kyle Chen

Eric Findlay (SBN 00789886)

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**ATTORNEYS FOR DEFENDANTS**

**ASUSTEK COMPUTER INC.**

**ASUS COMPUTER INTERNATIONAL**

**CERTIFICATE OF SERVICE**

The undersigned certifies that the foregoing document was filed electronically in compliance with Local Rule CV-5(a) on the 18th day of May, 2010. As such, this document was served upon all counsel of record deemed to have consented to electronic service via the Court's CM/ECF system. Local Rule CV-(5)(a)(3).

/s/ Kyle Chen

Kyle Chen

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